

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Salonius, <i>et al.</i>)	Int. Cl:	A01K 61/00
Patent No:	7,302,913 B2)	U.S. Cl.:	119/215
Issued:	December 4, 2007)	Atty Docket No.	N079 1050.1
)	Conf. No.	7063

For: **VACCINE AGAINST SALMONID RICKETTSIAL SEPTICAEMIA BASED ON
ARTHROBACTER CELLS**

SECOND REPLY TO PARTIAL DENIAL OF REQUEST FOR CORRECTION

DECISIONS AND CERTIFICATES OF CORRECTION BRANCH

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This letter is submitted as a request for reconsideration of the partial denial of the Patent Owner's Request for Correction filed April 23, 2008 and is responsive to the Patent Office communication mailed January 25, 2010.

Because the Patent Office communication mailed January 25, 2010 simply contains statements that are clearly in error, the Patent Owner again submits certain observations herein, even though such information and arguments are already of record, e.g., in the Patent Owner's submission of July 3, 2008. In the Office's letter of January 25, 2010, the Decisions & Certificates of Correction Branch states:

Respecting the alleged error, references that applicant wants considered are not located in file or any international file. Note the PCT/DO/EO/903 indicates that an information Disclosure Statement was filed, but does not indicate that the non-Patent literature was filed. Therefore, no correction(s) is in order here under United States Code (U.S.C.) 254 or 255 the code of Federal Regulation (C.F.R.) R 1.322 or R 1.323.

Contrary to the Office's assertions, the record indicates (apart from the examiner's markings on the Form PTO-1449 received by Applicants with the Office Action mailed November 29, 2006) that both the US national application file and the international file contain the references in question. Here, it should be noted that *the references alleged by the examiner to be missing from the file are cited in the International Search Report of the parent international application*. The PCT/DO/EO/903 contains the statement copied below (picture copy from document):

The following items have been received:

- Copy of the International Application filed on 01/11/2005
- Copy of the International Search Report filed on 01/11/2005
- Preliminary Amendments filed on 01/11/2005
- Information Disclosure Statements filed on 01/11/2005
- Oath or Declaration filed on 02/14/2005
- Copy of references cited in ISR filed on 01/11/2005
- U.S. Basic National Fees filed on 01/11/2005
- Priority Documents filed on 01/11/2005

Applicants have requested previously that the Office consider *the item third from the bottom* of this list. That is, the form states that "The following items have been received. . . . Copy of references cited in ISR filed on 1/11/2005."

Regarding Information Disclosure Statements submitted in US national stage applications, the Patent Owner wishes to reference MPEP §1893.03(g) - Information Disclosure Statement in a National Stage Application:

When all the requirements for a national stage application have been completed, applicant is notified (*Form PCT/DO/EO/903*) of the acceptance of the application under 35 U.S.C. 371, *including an itemized list of the items received*. The itemized list includes an indication of whether a copy of the international search report and copies of the references cited therein are present in the national stage file. The examiner *will* consider the documents cited in the international search

report, without any further action by applicant under 37 CFR 1.97 and 1.98, when both the international search report and copies of the documents are indicated to be present in the national stage file. The examiner will note the consideration in the first Office action. There is no requirement that the examiners list the documents on a PTO-892 form. See form paragraphs 6.53, 6.54, and 6.55 (reproduced in MPEP § 609.03<). Otherwise, applicant must follow the procedure set forth in 37 CFR 1.97 and 1.98 in order to ensure that the examiner considers the documents cited in the international search report.

MPEP §1893.03(g), Emphasis added. Regardless of their further citation by Applicants on the Form PTO-1449 (which was actually unnecessary for consideration – see the discussion of MPEP 1893.03(g) and the quoted passage above), the references sought to be added to the patent via Correction were cited in the ISR and were listed as “received” on the PCT/DO/EO/903. This is clear and indicates that the references in question were in the file, at least according to information communicated to Applicants by the US PTO on February 28, 2005.

Regarding the later marking of the Form PTO-1449 by the examiner, alleging that the references were missing and therefore not considered, the Patent Owner has previously pointed out that the Examiner is only to take this action if the citation is *not in conformance* and the reference is not considered. (See bottom of SB08A: "Draw line through citation if not in conformance and not considered"). It is clear that, in the present situation, Applicants' citations *were in conformance*. Further, copies of the references were acknowledged as received by the Office. Accordingly, the Office was obligated to list the references on the face page of the patent because the Applicants had satisfied all requirements. The examiner's notations were simply in error according to the direction printed on the PTO form itself (only proper if “the citation is *not in conformance* and the reference is not considered”).

The Examiner's mistaken notations on a copy of Applicants' PTO-1449 are not a sufficient reason to refuse to list those references on the face page of the patent. As noted, Applicants had complied with all requirements for such listing. In view of the foregoing, Patent Owner respectfully requests that the denial be reconsidered and that the Certificate of Correction issue as originally requested.

Final Note

The Patent Owner submits this rebuttal to the Office's position expressed in the January 25, 2010 letter only because it is believed that the Office's position is clearly in error. Pursuit of this Correction should not be taken to imply that the Patent Owner believes that the references in question are material to patentability or are not cumulative to references already listed on the published patent. Indeed, the Patent Owner believes that the references in question are either not material or are cumulative to the references listed. Correction is sought, nonetheless, because it is believed such correction is appropriate based on the record.

Respectfully submitted,



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Date: Feb 19, 2010

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